

Appn. No. 10/826,722
Amendment dated March 10, 2009
Reply to Office Action mailed December 11, 2008

REMARKS

Reconsideration is respectfully requested.

Status of Claims

Claims 2, 4 though 9 and 13 through 18 have been cancelled.

No claims have been withdrawn.

Claims 19 through 22 have been added.

Therefore, claims 1, 3, 10 through 12, and 19 through 22 are pending in this application.

Paragraphs 8 through 18 of the Office Action

Claims 17 and 18 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claim 17 and 18 have been amended to more accurately reflect the subject matter of the invention.

The §112 (first paragraph) rejection of claims 17 and 18 is therefore submitted to be moot.

Paragraph 10 of the Office Action

Claims 10 through 16 and 18 have been rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While it is not conceded that claim 10 (or claims 11 through 16 and 18) did not recite statutory subject matter, claim 10 has been amended in a manner submitted to further tie the subject matter to another statutory class of subject matter.

Withdrawal of the §101 rejection of claims 10 through 12 is therefore respectfully requested.

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Paragraphs 11 through 18 of the Office Action

Claims 1, 3 and 10 through 18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 132)

Claims 1 and 10 require, in part, "wherein the offer, if tailored for the third party, is based upon the profile distinction corresponding to the third party and is not based upon the profile corresponding to the user" and "wherein the offer, if tailored to the user, is not based upon the profile corresponding to the user and is not based upon the profile distinction associated with the third party".

It is conceded in the rejection that "Garrett does not specifically disclose" "determining an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party", and it is then contended that the Jacobi patent at column 6, lines 14-22 discloses "recommendations based on items in user's list".

However, it is submitted that the Jacobi patent does not disclose to one of ordinary skill in the art "determining an offer tailored to one or more of the user or to the third party *based upon either the profile corresponding to the user or the profile distinction associated with the third party*", particularly in which "the offer, if tailored for the third party, is based upon the profile distinction corresponding to the third party and is not based upon the profile corresponding to the user" and in which "the offer, if tailored to the user, is not based upon the profile corresponding to the user and is not based upon the profile distinction associated with the third party". In contrast, the Jacobi patent discusses a system in which recommendations are made "[u]sing the current and/or recent shopping cart contents" without regard for, or distinction between, if the contents of the cart or the

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recommendation is for the user or a third party. See, for example, Jacobi at col. 6, lines 14 through 22, where it states that:

Using the current and/or recent shopping cart contents as inputs tends to produce recommendations that are highly correlated to the current short-term interests of the user--even if these short term interests are not reflected by the user's purchase history. For example, if the user is currently searching for a father's day gift and has selected several books for prospective purchase, this method will have a tendency to identify other books that are well suited for the gift recipient.

As can be appreciated from the above portion of Jacobi, while there is some discussion of recommending books based upon "selected" books for prospective purchase, but there is no distinction made between if the "selected" books are for the user or for "father", and does not make any distinction as whether the recommended book is for the user or for "father". There is nothing here that discloses or suggests that there is any distinction made as to the ultimate recipient of the "selected" books or the recommended book. Instead, Jacobi simply makes recommendations based upon what is currently (and perhaps what was recently) "selected" without any determination if the current and recent selections are for different persons or different persons. Moreover, while this portion of Jacobi talks about "the short term interests of the user", it also talks about selecting books for "father" based upon "recent" and "current" selections that may or may not have been for "father".

It is conceded in the rejection that "Garrett does not specifically disclose" "presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion", and it is then contended that the Jacobi patent at column 4, lines 55-61 discloses "implementing a variety of recommendation services... generates personal recommendations".

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However, it is submitted that this section of the Jacobi patent does not disclose "presenting, by the computerized transaction system, the offer to the user", particularly in which "the offer, if tailored for the third party, is based upon the profile distinction corresponding to the third party and is not based upon the profile corresponding to the user" and in which "the offer, if tailored to the user, is not based upon the profile corresponding to the user and is not based upon the profile distinction associated with the third party". Looking to Jacobi at col. 4, lines 55 through 61, it states there that:

The site also implements a variety of different recommendation services for recommending book titles, music titles, and/or video titles to users. One such service, known as BookMatcher.TM., allows users to interactively rate individual books on a scale of 1 5 to create personal item ratings profiles, and applies collaborative filtering techniques to these profiles to generate personal recommendations.

There is nothing here that discloses or suggests that there is any discrimination between the person for which the recommendation is made and use of information specific to the person for that offer. It merely makes a general statement about making recommendations, but does not disclose to one of ordinary skill in the art that any distinction between the person for which the purchase is being made and what is being purchased.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Garrett and Jacobi set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1 and 15. Further, claim 3, which depends from claim 1 and claim 16, which depends from claim 15 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejections of claims 1, 3 and 10 through 12 is therefore respectfully requested.

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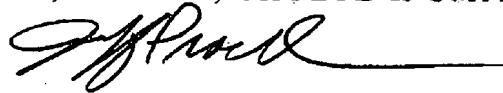
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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



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